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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,935	01/03/2007	Laetitia Maud Elysa Bouerat Duvold	3893-0227PUS2	9825

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EXAMINER	
KAROL, JODY LYNN	

ART UNIT	PAPER NUMBER
1627	

NOTIFICATION DATE	DELIVERY MODE
02/02/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/582,935	BOUERAT DUVOLD ET AL.	
	Examiner	Art Unit	
	Jody L. Karol	1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/15/2006*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-62* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 32-38 (in part), 40 (in part), 43, 52-55 (in part) and 56, drawn to a method of preventing, treating or ameliorating multiple sclerosis, comprising administering to a patient in need thereof, a pharmacologically effective amount of a compound of general formula I, wherein X=O and A=phenyl.

Group II, claim(s) 32-34 (in part), 36-38 (in part), 40 (in part), and 52-55 (in part), drawn to a method of preventing, treating or ameliorating multiple sclerosis, comprising administering to a patient in need thereof, a pharmacologically effective amount of a compound of general formula I, wherein X=S and A=phenyl.

Group III, claim(s) 32-39 (in part), 42, 45-50 (in part), and 51, drawn to a method of preventing, treating or ameliorating multiple sclerosis, comprising administering to a patient in need thereof, a pharmacologically effective amount of a compound of general formula I, wherein X=O and A=pyrrole.

Group IV, claim(s) 32-34 (in part) 36-39 (in part), and 45-50 (in part), drawn to a method of preventing, treating or ameliorating multiple sclerosis, comprising administering to a patient in need thereof, a pharmacologically effective amount of a compound of general formula I, wherein X=S and A=pyrrole.

Group V, claim(s) 32-38 (in part), 41 (in part), 44, 57-61 (in part), and 62, drawn to a method of preventing, treating or ameliorating multiple sclerosis, comprising administering to a patient in need thereof, a pharmacologically effective amount of a compound of general formula I, wherein X=O and A=indole.

Group VI, claim(s) 32-34 (in part), 36-38 (in part), 41 (in part), and 57-61 (in part), drawn to a method of preventing, treating or ameliorating multiple sclerosis, comprising

administering to a patient in need thereof, a pharmacologically effective amount of a compound of general formula I, wherein X=S and A=indole.

Group VII, claim(s) 32-37 (in part), drawn to a method of preventing, treating or ameliorating multiple sclerosis, comprising administering to a patient in need thereof, a pharmacologically effective amount of a compound of general formula I, wherein X=O and A=a monocyclic or bicyclic heteroaryl ring not phenyl, pyrrole, or indole.

Group VIII, claim(s) 32-34 (in part) and 36-37 (in part), drawn to a method of preventing, treating or ameliorating multiple sclerosis, comprising administering to a patient in need thereof, a pharmacologically effective amount of a compound of general formula I, wherein X=S and A= a monocyclic or bicyclic heteroaryl ring not phenyl, pyrrole, or indole.

Group IX, claim(s) 1-7 (in part), 9 (in part) 12, 21-24 (in part), and 25, drawn to the use of a compound of formula I, wherein X=O and A=phenyl, for the preparation of a medicament (i.e. a method of manufacturing a medicament comprising a compound of formula I).

Group X, claim(s) 1-3 (in part), 5-7 (in part), 9 (in part), and 21-25 (in part), drawn to the use of a compound of formula I, wherein X=S and A=phenyl, for the preparation of a medicament (i.e. a method of manufacturing a medicament comprising a compound of formula I).

Group XI, claim(s) 1-8 (in part), 11, 14-19 (in part), and 20, drawn to the use of a compound of formula I, wherein X=O and A=pyrrole, for the preparation of a medicament (i.e. a method of manufacturing a medicament comprising a compound of formula I).

Group XII, claim(s) 1-3 (in part), 5-8 (in part), and 14-19 (in part), drawn to the use of a compound of formula I, wherein X=S and A=pyrrole, for the preparation of a medicament (i.e. a method of manufacturing a medicament comprising a compound of formula I).

Group XIII, claim(s) 1-7 (in part), 10 (in part), 13, 26-30 (in part), and 31, drawn to the use of a compound of formula I, wherein X=O and A=indole, for the preparation of a medicament (i.e. a method of manufacturing a medicament comprising a compound of formula I).

Group XIV, claim(s) 1-3 (n part), 5-7 (in part), 10 (in part), and 26-30 (in part), drawn to the use of a compound of formula I, wherein X=S and A=indole, for the preparation of a medicament (i.e. a method of manufacturing a medicament comprising a compound of formula I).

Group XV, claim(s) 1-6 (in part), drawn to the use of a compound of formula I, wherein X=O and A= a monocyclic or bicyclic heteroaryl ring not phenyl, pyrrole, or indole I, for the preparation of a medicament (i.e. a method of manufacturing a medicament comprising a compound of formula I).

Group XVI, claim(s) 1-3 (in part), and 5-6 (in part), drawn to the use of a compound of formula I, wherein X=S and A= a monocyclic or bicyclic heteroaryl ring not phenyl, pyrrole, or indole, for the preparation of a medicament (i.e. a method of manufacturing a medicament comprising a compound of formula I).

2. The inventions listed as Groups I-XVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

3. An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The expression “special technical features” is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any). Whether or not any particular technical feature makes a “contribution” over the

prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step.

The common technical feature among the groups is a compound of formula I. The compound of formula I cannot be considered a special technical feature because it is known in the prior art. For example, Tang et al. teach indoline compounds that overlap with the compounds of formula I (see WO 96/40116 – cited on IDS). Accordingly, the unity of invention is considered to be lacking, and restriction in accordance with the rules of unity of invention is considered proper.

Election of Species

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

(1) Compounds of formula I

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. The claims are deemed to correspond to the species listed above in the following manner:

Claims 11-13, 20, 25, 31, 42-44, 51, 56, and 62 are directed to specific compounds.

The following claim(s) are generic: 1-10, 14-19, 21-24, 26-30, 32-41, 45-50, 52-55, and 57-61.

6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the species are known in the prior art as described *supra* (see Tang et al. - WO 96/40116).

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Inventorship Notice

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Correspondence

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jody L. Karol whose telephone number is (571)270-3283. The examiner can normally be reached on 8:30 am - 5:00 pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

JLK

/Yong S. Chong/
Primary Examiner, Art Unit 1627